

REMARKS

Claims 1-29 are pending in the present application. Claims 8, 19, and 23 are amended to place those claims into independent format. Claim 15 is amended to correct a minor typographical error. Reconsideration of the claims is respectfully requested.

I. Interview Summary

Examiner Huynh and Theodore D. Fay III discussed what claim limitations were patentable. The examiner affirmed that claims 8, 19, and 23 would be allowable if re-written in independent form. In addition, whether the proposed combination was non-obvious because MacKenty shows a linear reading of a web page was discussed. No agreement was reached.

II. Claim Objections

The examiner objected to claims 8, 19, and 23, indicating that these claims would be allowable if re-written in independent form. Applicants have amended claims 8, 19, and 23 accordingly.

III. 35 U.S.C. § 103, Obviousness

III.A. Basis of Rejections

The examiner has rejected claims 1-2, 4-7, 9-15, 17-18, 20-22, 24-29 under 35 U.S.C. § 103(a) as being unpatentable over MacKenty et al., Auditorially Representing Pages of SGML Data, U.S. Patent 6,088,675 (Jul. 11, 2000) in view of Maslov et al., Method for Extracting Digests, Reformatting, and Automatic Monitoring of Structured Online Documents Based on Visual Programming of Document Tree Navigation and Transformation, U.S. Patent 6,538,673 (Mar. 25, 2003). This rejection is respectfully traversed. (Throughout the quoted rejection, the examiner refers to McKenty and Maslow. In quoting the examiner, the inventors' names have been correctly spelled as MacKenty and Maslov.)

The examiner asserts that:

Regarding independent claim 1, MacKenty discloses:

parsing an electronic document into a parse tree (col 2, lines 60-67, col 4, lines 45-50)
a cursor is a reference to a particular position, or node, within a tree while traversing the tree data structure of the document, and the cursors may be used to interactively control the position of the SGML document being read aloud (col 5, lines 37-51)
receiving user input while the SGML document is being read and the reader stops at a current position (col 6, lines 1-12, 48-57)

MacKenty does not disclose:

receiving a user request for a description of cursor position in the electronic document

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified MacKenty to include receiving a user request for a description of cursor position in the electronic document for the following reason. The fact that a user input can be received during the reading of the electronic document at a cursor position and the reader stops reading suggests that a request for a description of the cursor position in the electronic document can also be made as a user input while the document is being read.

MacKenty also does not disclose:

using an algorithm to construct a position response by walking up the parse tree, from the tree node associated with the current position in the electronic document to the root of the electronic document
delivering the position response to the user

Maslov discloses walking up a document tree from the selected node to the root node to *find the tree node that corresponds to the document fragment selected by the user* (col 9, lines 5-18).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Maslov to use walking up the parse tree from the tree node to the root of the electronic document to find a requested position in a document made by a user since said requested position is considered as equivalent to the position of a fragment selected by a user, and finding the position of a fragment selected by a user is a type of request made by a user for a selected position.

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Maslov into

MacKenty for the following reason. Maslov discloses walking up the tree for finding the position of the fragment selected by a user providing the advantage to incorporate into MacKenty for quickly finding the current position by walking up the tree only from the current node to the root node instead of parsing the whole tree as usual to obtain the response of the cursor position requested by a user.

Also, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Maslov into MacKenty for delivering the position response to the user since finding the position as requested by a user suggests that a response to said request when found should be provided to the user.

Office Action of October 5, 2004 (pages 2 through 5).

III.B. The Examiner Has Failed to State Prima Facie Obviousness Rejections of Claim 1

III.B.1 The Proposed Combination Does Not Result in the Claimed Inventions

The proposed combination does not result in the invention of claim 1, which reads as follows:

1. A method for providing a description of current position in an electronic document, comprising:
 - parsing an electronic document into a parse tree;
 - receiving a user request for a description of cursor position in the electronic document;
 - using an algorithm to construct a position response by walking up the parse tree, from the tree node associated with the current position in the electronic document to the root of the electronic document; and
 - delivering the position response to the user.

Contrary to the examiner's assertions, neither MacKenty nor Maslov suggest constructing a position response or receiving a user request for a description of cursor position as claimed. MacKenty reads the entirety of a web page linearly, from beginning to end, as shown by the following text:

The SGML document is read by performing a depth first traversal of the parsed SGML document tree. Such a traversal corresponds

to reading the unparsed SGML document linearly, as it was written by the author.

MacKenty, col. 5, ll. 20-23. MacKenty tracks the position of a reading cursor, but never provides that position to the listener. MacKenty has no need to inform the listener of the position of the cursor because MacKenty reads a web page linearly, from beginning to end. Therefore, one of ordinary skill in the art would not be motivated to modify MacKenty and combine this reference with Maslov.

Similarly, linearly reading a web page is the entire point of MacKenty's patent. Thus, MacKenty does not show or suggest the limitations as claimed. Maslov is likewise silent on the issue of receiving a user request for a description of cursor position and constructing a position response as claimed. Accordingly, the proposed combination does not result in the claimed invention.

The examiner states that, "The fact that a user input can be received during the reading of the electronic document at a cursor position and the reader stops reading suggest that a request for a description of the cursor position in the electronic document can also be made a user input while the document is being read." However, the examiner's logic is flawed in that the asserted reason begs the question. The examiner's reasoning can be summarized as follows: The fact that a user input can be received suggests that a request for cursor position can also be made. However, the examiner has provided no reason as to *why* the request for cursor position should be made in the first place. The entire point of MacKenty's invention is to read linearly a web page from beginning to end. While reading a document linearly, no one of ordinary skill would have a reason to request the cursor position. Thus, not only has the examiner's reasoning failed, but MacKenty actually suggests the opposite conclusion. Maslov fails to cure the suggestion in MacKenty that one should avoid requesting, constructing, or delivering the cursor position in a manner similar to that claimed. Thus, the proposed combination does not result in the claimed inventions.

III.B.2 The Examiner Has Failed to Provide Proper Motivations to Combine the References and to Further Modify the Proposed Combination

Similarly, the examiner has failed to state prima facie obviousness rejections because the examiner has failed to provide a motivation to combine the references and failed to provide a motivation to further modify the proposed combination. The rejections rely on the following logic: (1) the combination of MacKenty and Maslov show all of the limitations of the claims except receiving a user request for a description of a cursor position, identifying the position by walking up a parse tree, and delivering the position response to the user, (2) that it would have been obvious to modify Maslov to show walking up the parse tree to identify the cursor position because the requested position is equivalent to the position of a fragment selected by a user, (3) that it would be obvious to combine MacKenty and Maslov to more quickly report the position, and (4) that it would be obvious to further modify MacKenty and Maslov to receive a user request for a description of a cursor position and deliver the position response to the user because, “The fact that a user input can be received during the reading of the electronic document at a cursor position and the reader stops reading suggest that a request for a description of the cursor position in the electronic document can also be made a user input while the document is being read.”

With respect to (2), the examiner states that it would have been obvious to modify Maslov to use walking up the parse tree to find a requested position, “since said requested position is considered as equivalent to the position of a fragment selected by a user, and finding the position of fragment selected by a user is a type of request made by a user for a selected position” (Emphasis in original). The examiner’s logic is flawed because requesting a position is not equivalent to the position selected by a user. Requesting a position means that the user actually requests the position of the cursor. The position of a fragment selected by a user is just that – the position of a fragment selected by the user. In Maslov’s disclosure, the user selects a fragment to be extracted into a digest. The position of that fragment is not requested by the user, even if Maslov’s method of translating the fragment into a digest requires knowing the position of the fragment within the parse tree. Because the two elements are different, the examiner’s logic fails.

In addition, even if the logic was correct, the fact that one element is equivalent to another does not provide a motivation to further modify the proposed combination. The examiner must provide a motivation to modify the references in order to state a prima

facie obviousness rejection under Graham v. John Deere. The mere fact that the prior art could be readily modified to arrive at the claimed invention does not render the claimed invention obvious; the prior art must suggest the desirability of such a modification. *In re Ochiai*, 71 F.3d 1565, 1570, 37 U.S.P.Q.2d 1127, 1131 (Fed. Cir. 1996); *In re Gordon*, 733 F.2d 900, 903, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Merely stating that the modification would have been obvious to one of ordinary skill without identifying an incentive or motivation for making the proposed modification is insufficient to establish a *prima facie* case. Accordingly, the examiner has failed to state *prima facie* obviousness rejections.

Turning back to element (3) of the examiner's logic, that it would be obvious to combine MacKenty and Maslov to report more quickly the position, the examiner has used impermissible hindsight when fashioning the obviousness rejection. Neither MacKenty nor Maslov show the advantage of walking up a parse tree to provide more quickly the position of a cursor. Maslov asserts that the reason for walking up a tree is to keep track of dynamic web pages, as shown by the following text:

Why the tree?

Every time we reload the source document, there is no guarantee that it will be the same as the previously loaded document or that it will even be close to the previously loaded document. Many things can change even in the relatively stable documents generated from online databases:

...

So to be able to find the user-selected fragment of the changed source online document we need to rely on a document model such that an algorithm of getting to the user selected fragment will be the least affected by changes in the other parts of the document.

Maslov, col. 10, ll. 5-11; 26-30. Maslov never states walking up a tree is a quicker way of reporting the position of a cursor. Only applicant's disclosure reveals this advantage. Thus, the examiner must have used this advantage when fashioning the obviousness rejections. In determining obviousness, an applicant's teachings may not be read into the prior art. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1575 n. 29, 1 U.S.P.Q. 1593, 1602 n. 29 (Fed. Cir. 1987) (citing need to "guard against hindsight and the temptation to read the inventor's teachings into the prior art"). A determination of the desirability of

combining prior art references must be made without the benefit of hindsight afforded by an applicant's disclosure. *In re Paulsen*, 30 F.3d 1475, 1482, 31 U.S.P.Q. 1671, 1676 (Fed. Cir. 1994). Because the examiner has used impermissible hindsight to construct a motivation to combine the references, the examiner has failed to state a proper motivation to combine the references. Thus, the examiner has also failed to state prima facie obviousness rejections.

Turning now to element (4) of the examiner's logic, that it would be obvious to further modify MacKenty and Maslov to receive a user request for a description of a cursor position and deliver the position response to the user, the examiner has again failed to state a proper motivation to modify the proposed combination. As shown above, the logic with respect to (4) is flawed because the reasoning fails to provide any reason why one of ordinary skill would request a description of cursor position, especially in the face of MacKenty's disclosure that the reading should be linear. Thus, the examiner has failed to provide a motivation to further modify the references and has failed to state prima facie obviousness rejections.

In addition, the examiner states that it would be obvious to combine the references to show delivering the position of the cursor, "since finding the position as requested by a user suggests that a response to said request when found should be provided to the user." Again, the examiner's logic is flawed. Just because a process has found a position of a cursor, even if prompted by a user, it is not necessarily true that the position be provided to the user. For example, MacKenty finds the position of the cursor as it reads the document. However, the position is not provided to the user because that information is unnecessary. Similarly, Maslov finds the position of user-selected text within a parse tree, though the position is not reported to the user because that information is extraneous to the production of the digest. In the light of both MacKenty and Maslov, there is no reason to assume that finding the position requested by a user means that the position should be provided to the user. Because the examiner's logic fails, the examiner has failed to state a proper motivation to combine the references. Accordingly, the examiner has failed to state prima facie obviousness rejections.

III.C. Claim 1 Is Non-Obvious Over the Proposed Combination

Even if the examiner had stated a prima facie obviousness rejection of claim 1, claim 1 would still be non-obvious over the cited references. First, the examiner's reasoning is too convoluted to support a finding that one of ordinary skill would find obvious the proposed combination and modification to the combination. Second, one of ordinary skill would be motivated to avoid combining the references. Third, no motivation or suggestion to combine the references exists within the references or within the art.

III.C.1 The Examiner's Reasoning Is Too Convoluted To Support a Finding that One of Ordinary Skill Would Find Obvious the Proposed Combination and the Modification to the Combination

The fact that the examiner's relies on convoluted reasoning shows that the claims are non-obvious over the cited references. In general, the rejection rests on first combining MacKenty and Maslov and then further modifying the proposed combination. The rejection may be summarized in more detail as follows: The claims are obvious over MacKenty and Maslov because (1) MacKenty shows an audible web page reader, (2) MacKenty does not show receiving a user request for a description of a cursor position, (3) MacKenty does show a user-requested stop at a cursor position, (4) the user-requested stop at a cursor position suggests that a request for a description of the cursor position can also be made, (5) Maslov shows "walking up" a parse tree of a web page, (6) the "requested position" suggested in MacKenty is equivalent to the position of a fragment selected by a user in Maslov, (7) finding the position of a fragment selected by a user is a type of request made by a user for a selected position, (8) that Maslov's technique would allow MacKenty to quickly find the current position by "walking up" the parse tree, and (9) that finding the position as requested by a user suggests that a response to said request should be provided to the user."

The examiner's convoluted reasoning, which requires over two pages to state, requires at least nine steps to combine the references and modify the references in at least three different ways. By the examiner's own admission, the proposed combination does not show (1) receiving a user request for a description of cursor position, (2) constructing

a position response by walking up the parse tree, or (3) delivering the position response to the user. These three elements form a significant portion of claim 1, so the examiner is extensively modifying the proposed combination. To do so, the examiner uses the convoluted logic described above. Because convoluted and erroneous logic is required to combine and then modify the references, one of ordinary skill simply would not think to combine the references and would not be motivated to further modify the combination of the references. Accordingly, the claims are non-obvious.

In addition, as described above, the examiner's convoluted reasoning is fundamentally flawed. Thus, again, claim 1 is non-obvious over MacKenty and Maslov.

III.C.2 One of Ordinary Skill Would Be Motivated To Avoid Combining the References

As described above, MacKenty shows linearly reading a web document. Linearly reading a document is the entire point of his patent. Maslov shows a method of transforming a web page into a digest containing only information important to a user. Among other techniques used to accomplish this task, Maslov determines the position of the user-selected text by walking up a parse tree. In the light of MacKenty's teaching regarding linearly reading a document, one of ordinary skill would be motivated to avoid combining Maslov with MacKenty because Maslov's procedure is irrelevant to MacKenty's invention. Thus, claim 1 is non-obvious.

III.C.3 No Motivation or Suggestion To Combine the References Exists within the References or within the Art

As described above, MacKenty shows linearly reading a web document. Maslov shows a method of transforming a web page into a digest containing only information important to a user. MacKenty and Maslov address completely different problems. MacKenty addresses a text-to speech translator for a web page and MacKenty addresses a web page to digest translator. Given that MacKenty and Maslov address completely different problems, there is no reason to combine the references when the references are viewed as a whole. Accordingly, claim 1 is non-obvious.

In addition, by the examiner's own admission, neither MacKenty nor Maslov show the steps of receiving a user request for a description of cursor position, using an algorithm to construct a position response, or delivering the position response to the user as claimed. Moreover, no such suggestion exists in the art for further modifying the proposed combination to meet these limitations. As described above, the examiner's assertions to the contrary are incorrect. Because no suggestion exists in the references or in the art to combine the references and then further modify the proposed combination, claim 1 is non-obvious over the cited references.

III.D. Rejection of Claims 2, 4-7, 9-15, 17-18, 20-22, and 24-29

Claims 2 and 4-7 depend on patentable claim 1 and are thus patentable over the proposed combination. In addition, these claims contain other features not shown or suggested by the cited art. For example, claim 2 claims that the position response is audible. Neither MacKenty nor Maslov shows or suggests this feature, contrary to the assertion by the examiner. The fact that MacKenty re-reads a missing part to a user, as asserted by the examiner, is irrelevant to whether MacKenty shows reading the position of the user. Moreover, no reason exists to assume that MacKenty would audibly read the position of the cursor to the user because MacKenty has no interest in reporting the position of the cursor to the user in the first place.

Regarding claims 9-15, 17-18, 20-22, and 24-29, these claims contain similar limitations to those of claim 1. Thus, for similar reasons, these claims are non-obvious over the combination and proposed modification of MacKenty and Maslov. Accordingly, the rejection of claims 1, 2, 4-7, 9-15, 17, 18, 20-22, and 24-29 has been overcome.

III.E. Rejection of Claims 3 and 16.

The examiner has rejected claims 3 and 16 under 35 U.S.C. § 103(a) as being unpatentable over MacKenty in view of Maslov as applied to claim 1 above, and further in view of Cragun, Touch Screen Apparatus with Tactile Information, U.S. Patent 5,412,189 (May 2, 1995). This rejection is respectfully traversed.

Regarding the rejections of claims 3 and 16, the examiner states as follows:

Regarding claim 3, which is dependent on claim 1, MacKenty and Maslov do not disclose that the position response is by means of a tactile feedback mechanism.

Cragun discloses a touch screen apparatus with tactile feedback information is added as a part of a desktop or laptop computer to improve the ease of use of a computer system for visually impaired users (abstract, col 1, lines 40-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Cragun into MacKenty since Cragun provides a touch screen with tactile feedback information added to a desktop or laptop computer for helping visually impaired users in using computer providing the advantage to incorporate into MacKenty and Maslov for giving the position response to users by means of a tactile feedback mechanism in addition to by means of an audio mechanism since tactile feedback mechanism is a helpful tool to make electronic documents accessible to visually impaired users.

Claim 16 includes the same limitations of claim 3, and is rejected under the same rationale

Office Action of October 5, 2004 (pages 14-15).

Claims 3 and 16 depend on claims 1 and 12 respectively, both of which are patentable over MacKenty and Maslov. Thus, claims 3 and 16 are patentable over the combination of MacKenty, Maslov, and Cragun.

In addition, the examiner failed to state *prima facie* obviousness rejections of claims 3 and 16 because the examiner has failed to state a proper motivation to combine the references. The examiner states that Cragun provides a touch screen with tactile feedback and that it would be obvious to incorporate tactile feedback into MacKenty and Maslov because doing so is a helpful tool to make electronic document accessible to visually impaired users. The examiner has stated a proposed advantage to the proposed combination, but has not stated *why* one of ordinary skill would be motivated to combine the references in the first place. In the light that neither MacKenty nor Maslov are interested in reporting the position of a cursor to a user, there is no reason for one of ordinary skill to provide a tactile feedback of the position of the cursor to the user. Thus,

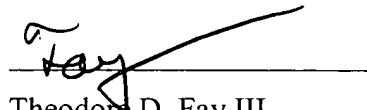
the examiner has failed to state a prima facie obviousness rejection of claims 3 and 16. Accordingly, the rejection of claims 3 and 16 has been overcome.

IV. Conclusion

It is respectfully urged that the subject application is patentable over MacKenty in view of Maslov, and further in view of Cragun and is now in condition for allowance. The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: January 12, 2005

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Fay', is written over a horizontal line.

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